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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,212	09/22/2000	Patrick Callaghan	END919990068US1	9821
26502	7590	01/24/2008		
IBM CORPORATION IPLAW SHCB/40-3 1701 NORTH STREET ENDICOTT, NY 13760			EXAMINER PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	
			MAIL DATE	DELIVERY MODE
			01/24/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK CALLAGHAN,
STEPHEN V. FEUSTEL,
MICHAEL J. HOWLAND,
and STEVEN M. PRITKO

Appeal 2007-1846
Application 09/668,212¹
Technology Center 2100

Decided: January 24, 2008

Before ALLEN R. MACDONALD, JAY P. LUCAS,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed September 22, 2000. The real party in interest is International Business Machines Corporation.

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 23-28 and 30.² We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to providing a synchronized presentation of the verbal and visual components of a HyperText Markup Language-like (HTML-like) form sent to a multi-modal browser having fields requiring user input and allowing the user to fill in the form with verbal or tactile interaction. (Spec. 1:6-11.)

Claims 23 and 30 are exemplary:

23. A method for completing a form, said method comprising the steps of:

a client workstation storing an audiovisual form in a written markup language, said form defining fields with respective headings and respective blank areas to be updated with text;

a web browser in said client workstation displaying said form with the respective headings and respective blank areas to be updated with text, audibly reading one of said headings and waiting for a user to audibly respond with corresponding

² Claims 22, 32-37, and 39-44 also are pending and have been finally rejected, but are not being appealed. (App. Br. 1.)

text for the blank area associated with said one heading; wherein while said browser audibly reads said one heading, without user selection of said one heading or the blank area associated with said one heading, said browser automatically displaying a plurality of valid alternatives for said blank area associated with said one heading, one of said valid alternatives being said corresponding text; and

in response to said user speaking said corresponding text, said browser displaying an updated state of the form with said one heading and with said corresponding text entered in said blank area associated with said one heading.

30. A method for completing a form, said method comprising the steps of:

a client workstation receiving from a server via a network an audiovisual form in a written markup language, said form including fields with respective headings and respective blank areas to be updated with text;

a web browser in said client workstation displaying said form with the respective headings and respective blank areas to be updated with text, audibly reading one of said headings and waiting a predetermined time for a user to audibly respond with corresponding text for the blank area associated with said one heading; and in response to lapse of said predetermined time, said web browser audibly rereading said one heading to

remind said user to audibly respond with
corresponding text for the blank area associated
with said one heading; and

instead of audibly responding with
corresponding text for the blank area associated
with said one heading, said user audibly
responding with a spoken command for said
browser to accept keyboard entry of the text for the
blank area associated with said one heading, and
based on said spoken command for said browser to
accept said keyboard entry, said browser accepting
subsequent keyboard entry of the text for said
blank area associated with said one heading.

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Dipaolo	5,367,619	Nov. 22, 1994
O'Sullivan	5,493,608	Feb. 20, 1996
Uppaluru	6,400,806 B1	Apr. 5, 1999

Claims 23-28 rejected under 35 U.S.C. § 103(a) as being obvious over
Uppaluru, O'Sullivan, and Dipaolo.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being obvious
over Uppaluru and O'Sullivan.

Rather than repeat the arguments of Appellants or the Examiner, we
make reference to the Brief and the Answer for their respective details.
Only those arguments actually made by Appellants have been considered in

this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R.

§ 41.37(c)(1)(vii).³

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants describe a multi-modal (e.g., audio-visual) browser that handles HTML-like forms which are presented to a user. (Spec. 3:9-11.) "The multi-modal browser serves the form via a synchronized verbal/visual presentation, and allows a user to fill in the form via either verbal or tactile interaction, or a combination thereof." (Spec. 3:16-18.)

The Specification further describes this synchronization as follows:

Referring now to Figure 2, the audio-visual modes of the multi-modal browser are synchronized as follows. If a selection box 202 is encountered during the audio presentation of the

³ Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

form, the visual representation of the selection box 202 may expand, or become enlarged, to display alternatives for selection. It should be noted that not all form elements need to "expand" and "contract". Form elements may also, for example, change color to indicate that they are "in scope" when the audio progression falls to them. Once the audio presentation corresponding to the selection box 202 is completed and the audio presentation moves on to the next form element 204, the visual representation of selection box 202 contracts, and the selection box 204 then expands or becomes enlarged. This tight coupling of the audio and visual presentation allows a user to quickly glance at the visual component should the audio presentation prove inadequate, and *vice-versa*. A common example of this is in the pronunciation of customer names. If the browser reads a customer name, the speech engine may mispronounce it. A quick glance to the visual component, however, allows the user to verify the intended information.

(Spec. 7:22 to 8:10.)

2. Uppaluru describes web pages that are formatted with extensions for voice information access and navigation, and are accessible to users through voice commands and touch tone inputs. (Col. 2, ll. 27-37; *see also, e.g.*, col. 4, ll. 44-49; col. 5, ll. 9-10; col. 6, ll. 53-55; col. 7, ll. 22-27, 40-47.) The web page can be navigated using a mouse, keyboard, and microphone. (Col. 8, ll. 2-8.) Voice prompts are provided to the

user to enter information. (Col. 8, ll. 31-35.) Uppaluru teaches that a set of command and control words (such as stop, start, play, pause, exit, backup, forward, continue, previous, next, home, reload, and help) are provided to enable user dependent but context independent navigation and control. (Col. 2, l. 65 to col. 3, l. 5; col. 8, ll. 42-51 *see also* col. 8, ll. 37-56.) Uppaluru teaches that commands may be entered using a telephone keypad or,

alternatively, by vocalizing the command. (Col. 8, ll. 57 to col. 9, l. 6; col. 26, ll. 8-18; col. 25, ll. 11-44.)

3. Dipaolo describes a system for data entry that generates variable menus of valid entries for selected menu fields to ensure the validity of data being entered. (Col. 2, ll. 43-50.) As shown in Figure 1, "when the user selects a menu driven field, a window 15 is presented on the screen next to the current field. This window contains the menu 16 listing current, valid values for that field." (Col. 6, ll. 19-22.)

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*;

see also In re Harris, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 23-28 as being obvious over Uppaluru, O'Sullivan, and Dipaolo, and in rejecting claim 30 over Uppaluru and O'Sullivan. Reviewing the documents of record and the findings of facts cited above, we agree. In particular, we find that

the Appellants have shown that the Examiner failed to make a prima facie showing of obviousness with respect to these claims.

With respect to claim 23, Appellants argue that neither Uppaluru, O'Sullivan, nor Dipaolo teach or suggest the limitation "wherein while said browser audibly reads said one heading, without user selection of said one heading or the blank area associated with said one heading, said browser automatically displaying a plurality of valid alternatives for said blank area associated with said one heading, one of said valid alternatives being said corresponding text," as claimed. (App. Br. 5-6.) We agree.

The Examiner found that Uppaluru discloses audibly prompting the user for input using voice prompts *"without user selection of said one heading or the blank area associated with said one heading."* (Ans. 8-9; *see also* Ans. 12-13.) The Examiner also found that, although "Uppaluru fails to explicitly teach *while said browser audibly reads said one heading, said browser automatically displaying a plurality of valid alternatives for said blank area associated with said one heading*" (Ans. 9), "Dipaolo teaches the automatic display of alternative values on a field, whenever a user selects the field" (Ans. 12-13).

We do not disagree with the Examiner's findings. Nevertheless, the Examiner has not shown, nor do we find, that the combined teachings of Uppaluru, Dipaolo, and O'Sullivan teach or suggest the limitation "wherein while said browser audibly reads said one heading, without user selection of said one heading or the blank area associated with said one heading, said browser automatically displaying a plurality of valid alternatives for said

blank area associated with said one heading, one of said valid alternatives being said corresponding text," as claimed. In particular, the plain language of the claim requires that the browser automatically display a plurality of valid alternatives for a blank area associated with a heading *without user selection of the heading or the blank area*. Dipaolo, however, requires *user selection* of the field in order to display the alternatives. (FF 3.) In short, the Examiner has not shown, nor do we find, anything Dipaolo, Uppaluru, or O'Sullivan that teaches or suggests displaying a plurality of valid alternatives *without* user selection of the heading or blank area.

Therefore, we conclude that the Examiner erred in rejecting claim 23. Claims 24-25 and 27-28 were not argued separately, and stand together with claim 23. Claim 26, which was separately argued (App. Br. 6-7), depends from claim 23 and we conclude that the Examiner erred in rejecting claim 26 for the same reasons discussed with respect to claim 23.

Regarding claim 30, Appellants argue that Neither Uppaluru nor O'Sullivan teach or suggest the limitation of "said user audibly responding with a spoken command for said browser to accept keyboard entry of the text for the blank area associated with said one heading," as claimed. (App. Br. 8-9.) We agree.

The Examiner found that, although Uppaluru fails to explicitly teach this limitation, "it would have been obvious . . . to respond with a keyword from a keyboard entry, because this would provide the benefit to input a piece of text quicker than using the voice response." (Ans. 6; *see also* Ans. 14.) We do not agree. Uppaluru teaches navigating a web page using a

mouse, keyboard, and microphone. (FF 2.) Uppaluru also teaches a set of command and control words, such as stop, start, play, pause, exit, backup, and forward, that are used for navigation of the web page and control of the voice browser. (FF 2.) However, we find no teaching or suggestion in either Uppaluru or O'Sullivan of a spoken command for the browser to accept keyboard entry of text.

Accordingly, we conclude that the Examiner erred in rejecting claim 30 under 35 U.S.C. § 103(a).

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

We make the following new ground of rejection using our authority under 37 C.F.R. § 41.50(b).

35 U.S.C. § 112, First Paragraph

Claims 23-28 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 23 recites "wherein while said browser audibly reads said one heading, *without user selection of said one heading or the blank area associated with said one heading*, said browser automatically displaying a plurality of valid alternatives for said blank area *associated with said one heading*." The italicized limitations were added by amendment on March 1, 2006, after the filing date of the instant Specification.⁴ The originally-filed Specification does not teach or describe a browser that displays a plurality of valid alternatives *without user selection* of the heading or blank area. Appellants point to the Specification from page 7, line 22 to page 8, line 10 for support. (App. Br. 3.) However, that portion of the Specification merely

⁴ Indeed, claim 23 itself was added by amendment received on October 3, 2005, after the filing date of the Specification.

teaches that if a selection box is encountered during the audio presentation of the form, the visual representation of the selection box may expand or become enlarged to display alternatives for selection and that when the audio presentation moves on to the next form element, that element then expands or becomes enlarged. (FF 1.) We do not find this to be a teaching that the browser automatically displays a plurality of valid alternatives for a blank area *without user selection* of the blank area or a heading with which the blank area is associated. Appellants have not pointed to, nor do we find, any other portion of the Specification to support this limitation.

Accordingly, the originally-filed Specification lacks written description support for the limitation "without user selection of said one heading or the blank area associated with said one heading" in the claim feature "wherein while said browser audibly reads said one heading, without user selection of said one heading or the blank area associated with said one heading, said browser automatically displaying a plurality of valid alternatives for said blank area associated with said one heading" recited by claim 23 and claims 24-28, which depend from claim 23.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the

following two options with respect to the new ground of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that:

(1) The Examiner erred in rejecting claims 23-28 and 30 for obviousness under 35 U.S.C. § 103.

(2) Claims 23-28 are unpatentable under 35 U.S.C. § 112, first paragraph, because they fail to comply with the written description requirement.

DECISION

The rejection of claims 23-28 and 30 for obviousness under 35 U.S.C. § 103 is reversed.

Claims 23-28 are rejected for failure to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

A new ground of rejection has been entered under 37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED

37 C.F.R. § 41.50(b)

Appeal 2007-1846
Application 09/668,212

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